

ATTENTION: PCT LEGAL OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#10

In re application of:
SACCO, et al.

Serial No.: 09/486,660

Int'l. Application No.: PCT/IT98/00231

I.A. Filing Date: 08/11/98

Title: TRANSGENIC ANIMALS FOR THE
STUDY OF BIOLOGICAL, PHYSICAL
AND CHEMICAL TOXIC AGENTS

* Attorney Docket No.: 3695-0101P

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Art Unit:

Examiner:

October 29, 2001

**SUPPLEMENTAL RENEWED REQUEST FOR STATUS
UNDER 37 CFR 1.42 AND
RENEWED PETITION UNDER 37 CFR 1.47(A)**

Box: PCT
Assistant Commissioner for Patents
Washington, DC 20231

Attention: PCT Legal Office

Sir:

RECEIVED
OCT 29 2001
TECHNOLOGY CENTER 3700
RECEIVED
21 DEC 2001
International Division

Supplementarily to the Renewed Request & Petition that was filed on September 28, 2001, we have now received a copy of a supplemental Combined Declaration and Power of Attorney duly executed by all of the living inventors herein. We have also received a copy of the Declaration/Power executed on behalf of Rachele Roncucci and of Regine Roncucci, who are minor heirs of Romeo Roncucci.

Should the PCT Legal Examiner wish to discuss any aspect of this matter with Applicants' representative, the PCT Legal Examiner is respectfully requested to telephone Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Richard Gallagher 28,781
for Joe McKinney Muncy
Reg. No. 32,334

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Enclosed:
Declaration/Power (living)
Declaration/Power (Rachele/Regine)

PLEASE NOTE:
YOU MUST
COMPLETE THE
FOLLOWING

BIRCH, STEWART, KOLASCH & BIRCH, LLP

P.O. Box 747 • Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000 • Facsimile: (703) 205-8050

LIVING

COMBINED DECLARATION AND POWER OF ATTORNEY FOR PATENT AND DESIGN APPLICATIONS

As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated next to my name; that I verily believe that I am the original, first and sole inventor (if only one inventor is named below) or an original, first and joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Insert Title:

TRANSGENIC ANIMALS FOR THE STUDY OF BIOLOGICAL, PHYSICAL AND CHEMICAL TOXIC AGENTS

Fill in Appropriate
Information -
For Use Without
Specification
Attached:

the specification of which is attached hereto. If not attached hereto,

the specification was filed on 28 February 2000 as

United States Application Number 09/186,660

and amended on 28 February 2000 and 19 December 2000 (if applicable) and/or

the specification was filed on 11 August 1998 as PCT

International Application Number PCT/IT98/00231 and was

amended under PCT Article 19 on _____ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I do not know and do not believe the same was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to this application, that the same was not in public use or on sale in the United States of America more than one year prior to this application, that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representative or assigns more than twelve months (six months for designs) prior to this application, and that no application for patent or inventor's certificate on this invention has been filed in any country foreign to the United States of America prior to this application by me or my legal representatives or assigns, except as follows.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

Priority Claimed

Insert Priority
Information:
(if appropriate)

MI97A 001972
(Number)

Italy
(Country)

August 28, 1997
(Month/Day/Year Filed)

☒ Yes ☐ No

(Number)

(Country)

(Month/Day/Year Filed)

☐ Yes ☐ No

(Number)

(Country)

(Month/Day/Year Filed)

☐ Yes ☐ No

(Number)

(Country)

(Month/Day/Year Filed)

☐ Yes ☐ No

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional applications(s) listed below.

Insert Provisional
Application(s):
(if any)

(Application Number)

(Filing Date)

All Foreign Applications, if any, for any Patent or Inventor's Certificate Filed More than 12 Months (6 Months for Designs) Prior to the Filing Date of This Application:

Country

Application Number

Date of Filing (Month/Day/Year)

Insert Requested
Information:
(if appropriate)

I hereby claim the benefit under Title 35, United States Code, §120 of any United States and/or PCT application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States and/or PCT application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose information which is material to the patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

Insert Prior U.S.
Application(s):
(if any)

(Application Number)

(Filing Date)

(Status - patented, pending, abandoned)

(Application Number)

(Filing Date)

(Status - patented, pending, abandoned)

I hereby appoint the practitioners at CUSTOMER NO. 2292 as my attorneys or agents to prosecute this application and/or an international application based on this application and to transact all business in the United States Patent and Trademark Office connected therewith and in connection with the resulting patent based on instructions received from the entity who first sent the application papers to the practitioners, unless the inventor(s) or assignee provides said practitioners with a written notice to the contrary.

Send Correspondence to:

BIRCH, STEWART, KOLASCH & BIRCH, LLP at CUSTOMER NO. 2292

P.O. Box 747 • Falls Church, Virginia 22040-0747

Telephone: (703) 205-8000 • Facsimile: (703) 205-8050

PLEASE NOTE:
YOU MUST
COMPLETE
THE
FOLLOWING:

Full Name of First
Inventor:
Last Name &
First Name &
Last Name of Spouse

Last Name &
First Name of Spouse

Last Name &
First Name of Spouse

Full Name of Second
Inventor if any
see above

Full Name of Third
Inventor if any
see above

Full Name of Fourth
Inventor if any
see above

Full Name of Fifth
Inventor if any
see above

Full Name of Sixth
Inventor if any
see above

GIVEN NAME/FAMILY NAME Maria Grazia SACCO	INVENTOR'S SIGNATURE <i>Maria Grazia Sacco</i>	DATE* 09.10.01
Residence (City, State & Country) Milano, Italy		CITIZENSHIP Italian
MAILING ADDRESS (Complete Street Address including City, State & Country) Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		
GIVEN NAME/FAMILY NAME Luigi ZECCA	INVENTOR'S SIGNATURE <i>Luigi Zecca</i>	DATE* 9 October 01
Residence (City, State & Country) Milano, Italy		CITIZENSHIP Italian
MAILING ADDRESS (Complete Street Address including City, State & Country) Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		
GIVEN NAME/FAMILY NAME Peter BROMLEY	INVENTOR'S SIGNATURE <i>Pete Bromley</i>	DATE* 25.09.01
Residence (City, State & Country) Geneva, Switzerland		CITIZENSHIP British
MAILING ADDRESS (Complete Street Address including City, State & Country) Gene Control S.A., 9 Rue Boissier, CH-1211 Geneva 24, Switzerland		
GIVEN NAME/FAMILY NAME Romano RONCUCCI (deceased)	INVENTOR'S SIGNATURE _____	DATE* _____
Residence (City, State & Country) Milano, Italy		CITIZENSHIP Italian
MAILING ADDRESS (Complete Street Address including City, State & Country) _____		
GIVEN NAME/FAMILY NAME Libero A. CLERICI	INVENTOR'S SIGNATURE <i>Libero Clerici</i>	DATE* 10.10.01
Residence (City, State & Country) Ispaa, Italy		CITIZENSHIP Italian
MAILING ADDRESS (Complete Street Address including City, State & Country) Joint Research Center, Environment Institute, 21027 Ispaa, Italy		
GIVEN NAME/FAMILY NAME Paoletto VEZZONI	INVENTOR'S SIGNATURE <i>Paoletto Vezzi</i>	DATE* 09.10.01
Residence (City, State & Country) Milano, Italy		CITIZENSHIP Italian
MAILING ADDRESS (Complete Street Address including City, State & Country) Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		

Date: 05/29/02

*DATE OF SIGNATURE

PLEASE NOTE:
YOU MUST
COMPLETE THE
FOLLOWING

BIRCH, STEWART, KOLASCH & BIRCH, LLP

P.O. Box 747 • Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000 • Facsimile: (703) 205-8050

RACHELE/REBINE

COMBINED DECLARATION AND POWER OF ATTORNEY FOR PATENT AND DESIGN APPLICATIONS

As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated next to my name; that I verily believe that I am the original, first and sole inventor (if only one inventor is named below) or an original, first and joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Insert Title: TRANSGENIC ANIMALS FOR THE STUDY OF BIOLOGICAL, PHYSICAL AND CHEMICAL TOXIC AGENTS

Fill in Appropriate Information - For Use Without Specification Attached: the specification of which is attached hereto. If not attached hereto, the specification was filed on 28 February 2000 as United States Application Number 09/186,660 and amended on 28 February 2000 and 19 December 2000 (if applicable) and/or the specification was filed on 11 August 1998 as PCT International Application Number PCT/IT98/00231 and was amended under PCT Article 19 on _____ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I do not know and do not believe the same was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to this application, that the same was not in public use or on sale in the United States of America more than one year prior to this application, that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representative or assigns more than twelve months (six months for designs) prior to this application, and that no application for patent or inventor's certificate on this invention has been filed in any country foreign to the United States of America prior to this application by me or my legal representatives or assigns, except as follows.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Insert Priority Information: (if appropriate)	Prior Foreign Application(s)	Priority Claimed
	<u>MI97A 001972</u> <u>Italy</u> <u>August 28, 1997</u>	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
	(Number) (Country) (Month/Day/Year Filed)	
	(Number) (Country) (Month/Day/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No
	(Number) (Country) (Month/Day/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No
	(Number) (Country) (Month/Day/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional applications(s) listed below.

Insert Provisional Application(s): (if any)	(Application Number)	(Filing Date)

All Foreign Applications, if any, for any Patent or Inventor's Certificate Filed More than 12 Months (6 Months for Designs) Prior to the Filing Date of This Application:

Insert Requested Information: (if appropriate)	Country	Application Number	Date of Filing (Month/Day/Year)

I hereby claim the benefit under Title 35, United States Code, §120 of any United States and/or PCT application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States and/or PCT application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose information which is material to the patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

Insert Prior U.S. Application(s): (if any)	(Application Number)	(Filing Date)	(Status - patented, pending, abandoned)

I hereby appoint the practitioners at CUSTOMER NO. 2292 as my attorneys or agents to prosecute this application and/or an international application based on this application and to transact all business in the United States Patent and Trademark Office connected therewith, and in connection with the resulting patent based on instructions received from the entity who first sent the application papers to the practitioners, unless the inventor(s) or assignee provides said practitioners with a written notice to the contrary.

Send Correspondence to:

BIRCH, STEWART, KOLASCH & BIRCH, LLP **at CUSTOMER NO. 2292**

P.O. Box 747 • Falls Church, Virginia 22040-0747

Telephone: (703) 205-8000 • Facsimile: (703) 205-8050

PLEASE NOTE:
YOU MUST
COMPLETE
THE
FOLLOWING:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of First
Inventor:
Last Name, First Name,
Middle Name, Suffix

Last Name, First Name,
Middle Name, Suffix

Last Name, First Name,
Middle Name, Suffix

Full Name of Second
Inventor, if any:
Last Name, First Name,
Middle Name, Suffix

Full Name of Third
Inventor, if any:
Last Name, First Name,
Middle Name, Suffix

Full Name of Fourth
Inventor, if any:
Last Name, First Name,
Middle Name, Suffix

Full Name of Fifth
Inventor, if any:
Last Name, First Name,
Middle Name, Suffix

Full Name of Sixth
Inventor, if any:
Last Name, First Name,
Middle Name, Suffix

GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Maria Grazia SACCO	<i>Maria Grazia Sacco</i>	09.10.01
Residence (City, State & Country)	CITIZENSHIP	
Milano, Italy	Italian	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		
GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Luigi ZECCA	<i>Luigi Zecca</i>	9 October '01
Residence (City, State & Country)	CITIZENSHIP	
Milano, Italy	Italian	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		
GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Peter BROMLEY	<i>Pete Bromley</i>	25.09.01
Residence (City, State & Country)	CITIZENSHIP	
Geneva, Switzerland	British	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
Gene Control S.A., 9 Rue Boissier, CH-1211 Geneva 24, Switzerland		
GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Romano BONCUCCI (deceased)		
Residence (City, State & Country)	CITIZENSHIP	
Milano, Italy	Italian	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Libero A. CLERICI	<i>Libero A. Clerici</i>	10.10.01
Residence (City, State & Country)	CITIZENSHIP	
Ipsa, Italy	Italian	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
Joint Research Center, Environment Institute, 21027 Ipsa, Italy		
GIVEN NAME/FAMILY NAME	INVENTOR'S SIGNATURE	DATE
Paslo VEZZONI	<i>Paslo Vezoni</i>	09.10.01
Residence (City, State & Country)	CITIZENSHIP	
Milano, Italy	Italian	
MAILING ADDRESS (Complete Street Address including City, State & Country)		
Institute of Advanced Biomedical Technologies, CNR, 56 Via Ampere, 20131 Milano, Italy		

Rev. 05/22/00

*DATE OF SIGNATURE

**ADDED PAGE TO COMBINED DECLARATION AND POWER OF
ATTORNEY FOR SIGNING BY ADMINISTRATOR(TRIX),
EXECUTOR(TRIX) OR LEGAL REPRESENTATIVE ON BEHALF OF
DECEASED OR INCAPACITATED INVENTOR (37 CFR 1.42 AND 1.43)**

I Maria Novella CASTAGNOLI

(Type or print name(s) of administrator(trix), executor(trix) legal representative or all heirs)

hereby declare that I am a citizen of Italy

address Via Ungaretti 17

20028 San Vittore Olona, Milano, Italy

and that I am executing and signing the declaration to which this is attached as (check one):

☐
☐
☒

the administrator(trix) of
executor(trix) of the last will and testament of
legal representative (guardian) of Rachele RONCUCCI and of
Regine RONCUCCI, who are minor heirs of Romeo RONCUCCI

Full name of (first, second, etc.) deceased or incapacitated inventor

Romeo RONCUCCI

Country of citizenship of deceased or incapacitated inventor

Italy

Residence (City, State, and Country) of deceased or incapacitated inventor

Milano, Italy

Mailing Address of deceased or incapacitated inventor

Via Ampere 56, Milano, Italy

NOTE:

The name of the first, second etc. deceased or incapacitated inventor should preferably also be filled in at the appropriate prior space of the declaration adding the words "deceased-completed on added page" or "incapacitated-completed on added page."

That, upon information and belief, I aver those facts which the inventor is required to state.

Date: 10/10/2004

Maria Novella Castagnoli
(Signature of administrator(trix), executor(trix)
legal representative (or all heirs))

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
SACCO, et al.

Serial No.: 09/486,660

Int'l. Application No.: PCT/IT98/00231

I.A. Filing Date: 08/11/98

Title: TRANSGENIC ANIMALS FOR THE
STUDY OF BIOLOGICAL, PHYSICAL AND
CHEMICAL TOXIC AGENTS

* Attorney Docket No.: **471-129P**

*

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* Art Unit:

*

* Examiner:

*

*

*

*

DECLARATION UNDER 37 CFR 1.132

Box: PCT
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

I, Peter Bromley, declare and say as follows:

I am the Peter Bromley who is one of the co-Inventors in the subject U.S.
patent application.

I have been informed that our Italian patent attorneys were having difficulty
in obtaining execution of the necessary Declaration and Power of Attorney form
(attached to a copy of the patent application) by Anne Georgette Cristiane Delachet,
guardian of Roxanne Roncucci, a minor heir of our deceased co-Inventor Romeo
Roncucci.

I have personally attempted to obtain her signature on the application papers.

SN 09/486,660
Bromley Declaration
Page 2

I was informed some months ago by Paolo Vezzoni of the CNR of the difficulty that the CNR patent lawyers were having in obtaining the signature of one of the heirs of my co-inventor Romeo Roncucci, but I was not informed who the heir was. Until 10 days ago, essentially no patent information was communicated to me by the CNR patent lawyers, and this in spite of my company, Gene Control S.A., being a 40% owner of the cited patent applications.

On Friday October 13th, 2000, our Italian lawyer who was negotiating for a year with the CNR to both improve communications, and to offer to buy out the CNR's part in ownership of the cited Intellectual Property, faxed the information that the CNR agreed to sell. He also transmitted information from the CNR that one of Romeo Roncucci's ex wives was the person who was refusing to sign the Declaration for the United States patent Application and the Assignment. He explained that apparently this person has a total aversion to the CNR.

We were also informed that her signature was required before October 28th, and should preferably be supplied to the CNR lawyers before October 23rd. This thus became Gene Control S.A.'s responsibility, and we were given ten days to react.

On October 17th I received documentation from the CNR lawyers showing that they had made numerous written communications and phone conversations with Ms. Delachet concerning the required signatures, and this as early as May 2000. Unfortunately they do not have her phone number. I obtained a phone number for her, but apparently an Association number and not a home phone number, which is on the restricted list in France. I, and one of my associates, both managed to speak

SN 09/486,660
Bromley Declaration
Page 3

to someone at the Association number, and were told that Mrs Delachet was in a meeting and that we should call back later. I called back and spoke to the same person as before. She said that the meeting was not finished but if I left my phone coordinates, Mrs Delachet would call me back. I left my coordinates but never received a call from her. I called again over three days, but always found an answering machine on; I left multiple messages explaining the situation, my phone coordinates again, but heard nothing back.

On October 19th and again on October 20th, I sent a letter to Mrs Delachet by DHL explaining the situation and the need for a rapid signature; the documents to be signed were included in each letter. I plan to go to Nice, France on Monday, October 20th to try and see Mrs Delachet.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: October 20th 2000

Peter Bromley.
Peter Bromley